

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/298,245 04/23/99 CHEN

J 75370029

EXAMINER

HM12/0213

BERNE S BROADBENT
KIRTON & MC CONKIE
1800 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY UT 84145

MCQUEENEY, P

ART UNIT

PAPER NUMBER

1615
DATE MAILED:

02/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/298,245	CHEN, JAU-FEI
	Examiner P. E. McQueeney	Art Unit 1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 17 November 2000.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9, 13-23 & 27-30 is/are pending in the application.

4a) Of the above claim(s) 10-12 & 24-26 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 5.

18) Interview Summary (PTO-413) Paper No(s). _____.

19) Notice of Informal Patent Application (PTO-152)

20) Other: _____

DETAILED ACTION

1. Acknowledgement is made of applicant's supplemental information disclosure statement filed October 16, 2000 and amendment filed November 17, 2000. Acknowledgement is further made of applicant's request for a copy of the information disclosure statement filed December 22, 1999 and said copy is included.

Information Disclosure Statement

2. The listing of references in the amendment is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Election/Restrictions

3. Claims 10-12 and 24-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

4. Applicant's arguments with respect to claims 1-9, 13-23, 27 and 28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the limitation "said botanical ingredient" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-9, 13, 16-19, 22, 23 and 27-30 are rejected under 35 U.S.C. 102(a) as being anticipated by E. Excel International's All-Day Hydrating Nourisher for Dry Skin, Replenishing Masque for Normal Skin, Hydrating Oil-Free Nourisher, Time Signature's Cactus Ginseng Essence, Time Signature's Pure Cactus Ginseng Masque, Time Signature's Replenishing Hand Cream, Protective Body Sunscreen, Body Nourisher, Body Wash, Moisturizing Bath, Cactus Ginseng Berry Cleanser, Sere Antiperspirant/Deodorant, Glisten, Brushing Bubbles, Artic Whisper, Multi-Action Shampoo, Anti-Dandruff Shampoo, Shampoo for Kids, Moisturizing Conditioner, and

Intensive Hair Treatment (hereinafter "E. Excel products"). The entry to this web page has a copyright date of 1998 (see <http://www.eexcel.net>).

Claim Rejections - 35 USC § 103

7. Claims 1-9, 13, 16-19, 22, 23 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. Excel products. E. Excel products disclose all the aspects of the claimed invention discussed above. Therefore it would have been obvious to one of ordinary skill in the art to make applicant's composition based on the disclosure of E. Excel products because the prior art teaches the exact limitations of applicant's invention.

8. Claims 1-9, 13-19, 22, 23 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. Excel products, as discussed above, further in view of Desert Lil's Delicacies and Van Wessern *et al.* (US 3,227,616). E. Excel products do not disclose the source of their ginseng (applicant's claims 14 and 15). It is the position of the examiner that the sources of ginseng are well known. To support this statement, reference is made to the web page submitted by applicant entitled Desert Lil's Delicacies which discusses the fact that the prickly pear cactus is a member of the Opuntia genus. Further support is found in Van Wessern *et al.* in col. 1, lines 26-30, discussing the cactus, Opuntia vulgaris. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize cacti from either the

Opuntia genus or Opuntia vulgaris because these two sources are common sources for cacti. The expected result would be products made from cactus fruit extract.

9. Claims 1-9, 13, 16-19, 21-23 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. Excel products, as discussed above, in view of applicant's admission starting as the last sentence of page 7 and including the first paragraph of page 8 and Van Wessern (US 3,227,616), Kashibuchi *et al.* (US 5,565,207), Meybeck *et al.* (US 5,663,160) and Emerson *et al.* (US 5,676,958).

E. Excel products do not list ginseng extract in their formulations. It is the position of the examiner that ginseng root extract is known in primary skin care products, topical skin applications, body treatment compositions and dental care products as evidenced by the above referenced disclosures. Applicant states at the last sentence of page 7 to the top of page 8 that "[c]ertainly, ginseng root extracts can be added to the novel skin care products, topical skin applications, body treatment compositions, and dental care products of the present invention, ..." Kashibuchi *et al.* disclose a scalp-moisturizer or external skin preparation. Kashibuchi *et al.* include ginseng extracts as sebum secretion inhibitors in their scalp moisturizer (col. 5, lines 63-67). Meybeck *et al.* disclose a cosmetic or dermatological composition. Meybeck *et al.* disclose the use of ginseng for arresting and/or slowing down hair loss (col. 2, lines 1-3). Emerson *et al.* disclose methods and compositions based upon natural aromatic aldehydes. Emerson *et al.* disclose the use of ginseng extract as an insecticide that is non-toxic to humans and higher animals (col. 6, line 47 through col. 7, line 64). It would

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have been obvious to a person of ordinary skill in the art at the time the invention was made to include ginseng root extract in the teachings of E. Excel products because ginseng root extract is known in primary skin care products, topical skin applications, body treatment compositions and dental care products as a serum inhibitor (Kashibuchi *et al.*), to prevent hair loss (Meybeck *et al.*) and to provide a non-toxic insecticide to the formulation (Emerson *et al.*). The expected result would be a successful primary skin care products, topical skin applications, body treatment compositions and dental care products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. E. McQueeney whose telephone number is 703-306-5827. The examiner can normally be reached on M, T, H, F 7:45 AM to 6:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3592 for regular communications and 703-308-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

pem
February 5, 2001


THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600